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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,320	11/25/1998	JOHANN KLEIN	Q051986	3573

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DAVID J CUSHING
SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 200373213

EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/199,320

Applicant(s)

KLEIN, JOHANN

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-4 and 6-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman

(United States Patent 5,483,586), in view of Peterson (United States Patent 5,1509,049).

Regarding **claim 1**, Sussman discloses an electronic on-line subscriber telephone directory. In addition, Sussman discloses a process for transmitting a telephone directory, which includes telephone numbers of a desired subscriber, from a central telephone directory service provider, which reads on claimed "directory enquiry facility", to a residential subscriber's telephone circuitry (6) and integrated electronic telephone directory (7), which reads on claimed "terminal", that is connected to the central telephone directory service provider over a common carrier telecommunications switching network (CCTSN) (4), as disclosed at column 2, line 44 through column 3, line 55 and exhibited in figure 1, the process comprising:

transmitting a request to receive updated on-line directory, which reads on claimed "transmitting an enquiry with the data", wherein the telephone directory includes telephone numbers of a desired subscriber, the request is sent from the residential

subscriber's telephone circuitry (6) and integrated electronic telephone directory (7) to the central telephone directory service provider, as disclosed at column 2, line 51 through column 3, line 13 and exhibited in figures 1 and 2;

the telephone directory data (including telephone numbers) is transmitted from the central telephone directory service provider digitally , which reads on claimed "numeric string" to the residential subscriber's telephone circuitry (6) and integrated electronic telephone directory (7); as disclosed at column 2, line 51 through column 3, line 13 and exhibited in figures 1 and 2;

the digital data is received at the residential subscriber's telephone circuitry (6) and integrated electronic telephone directory (7), as disclosed at column 3, lines 25-49 and exhibited in figures 1 and 2;

determining the telephone number from the digital data as disclosed at column 5, line 48 through column 6, line 39 and exhibited in figure 9;

storing the telephone number selected from the directory in the user directory memory (10) of the integrated electronic telephone directory (7) for direct dialing of the telephone number , as disclosed at column 4, lines 38-64 and exhibited in figure 10.

However, Sussman fails to disclose a telecommunication network with a first channel for voice transmission and a second channel for data transmission, transmitting on the first channel, and receiving on the second channel. However, the examiner maintains that it was well known in the art to provide a telecommunication network with a first channel for voice transmission and a second channel for data transmission, transmitting on the first channel and receiving on the second channel, as taught by Peterson.

In a similar field of endeavor Peterson discloses a automatic dialing of number received from directory assistance from within a cellular system. In addition, regarding the telecommunication network with a first channel for voice transmission and a second channel for data transmission, Peterson discloses, wherein the mobile telephone switching office (MTSO) (51), of a cellular communications system (50), which reads on claimed "telecommunication network", may be accomplished using any of a number of protocols (e.g., an integrated services digital network (ISDN)), the ISDN having 2-B channels and 1-D control channel, as discloses at column 7, lines 26-49 and exhibited in figures 1 and 2. Regarding receiving on the second channel, the second channel (D-channel), in an ISDN system as described by Peterson, it is inherent that the D-channel can carry data in addition to control and signaling information. Regarding transmitting on the first channel, it is further inherent to an ISDN system that the B-channels are provided to carry voice communication.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sussman by specifically providing a telecommunication network with a first channel for voice transmission and a second channel for data transmission, as taught by Peterson, for the purpose of providing digital communication capability.

Regarding **claim 2**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 1), in addition Sussman discloses wherein the central telephone directory service provider issues an action command for the residential subscriber's telephone circuitry (6) and integrated electronic telephone

directory (7) via CPU circuitry (12) to update the locally stored telephone numbers stored in the memory databases (directory memory (9) and user directory memory (10)), as disclosed at column 3, line 13 through column 4, line 63.

Regarding **claim 3**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 1), in addition Sussman discloses display unit (16) whereby a telephone number is display, as disclosed at column 5, lines 11-17 and exhibited in figure 2.

Regarding **claim 4**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 1), in addition claim 4 is interpreted and thus rejected for the reason set forth above in the rejection of claim 1.

Regarding **claim 6**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 1), in addition Sussman discloses whereby the central telephone directory service provider send the telephone directory data to the residential subscriber. The data includes both names, addresses and numbers of persons/businesses, which is inherently alphabetical and numerical data, which reads on claimed "alpha-numeric string", when the data is received the users has the capability to display it via display unit (16), as disclosed at column 3, lines 25-27 and column 5, lines 11-18 and exhibited in figure 2.

Regarding **claim 7**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 1), in addition Sussman discloses a keyboard unit (17) and interface circuit (15) by which the user sends request, as disclosed at column 5, lines 6-10 and exhibited in figure 2. Further, the Sussman combination discloses

sending data (in the form of a request), which reads on claimed "sends a message", to the central telephone directory service provider, indicating the date and time for updating the local directory, which reads on claimed "further information", via the second channel as disclosed by Peterson.

Regarding **claims 8 and 10**, it is interpreted and thus rejected for the reasons set forth above in the rejection of claims 1 and 2.

Regarding **claim 9**, Sussman and Peterson, the combination disclose everything claimed as applied above (see claim 6), in addition claim 9, is interpreted and thus rejected for the reason set forth above in the rejection claims 1 and 2.

Regarding **claim 11**, Sussman and Peterson disclose the process as described above in the rejection of claim 1, claim 11 provides a means for performing the process, since **claim 11** discloses a means that corresponds to the process of **claim 1**, the means is inherent in that it simply provides a functional implementation for the process found in **claim 1**, thus claim 11 is interpreted and rejected for the reasons set forth above in the rejection of claim 1.

2. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman, Peterson as applied to claim 1 above, and further in view of Rondeau.

Regarding **claim 5**, Sussman and Peterson, the combination, disclose everything claimed as applied above (see claim 1), however, the combination fails to disclose wherein the telecommunication network is a GSM mobile telephone network and the second channel is an organizational channel of the mobile telephone network. However, the examiner maintains that it was well known in the art to provide wherein

the telecommunication network is a GSM mobile telephone network and the second channel is an organizational channel of the mobile telephone network, as taught by Rondeau.

In a similar field of endeavor Rondeau discloses a system and method for providing an on-line directory service. In addition, Rondeau discloses a global system for mobile communications as a telecommunications network, as disclosed at column 6, line 29-49 and exhibited in figure 1. Regarding the second channel is an organization channel, it is inherent to GSM that a second channel is provided and the second channel may be used for organization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing a GSM mobile telephone network and the second channel is an organizational channel of the mobile telephone network, as taught by Rondeau, for the purpose of provide low-bit rate encoding.

Response to Arguments

Applicant's arguments filed July 24, 2002, have been fully considered but they are not persuasive.

Regarding applicant's argument concerning a D-channel carrying data, the examiner respectfully disagrees, the D-channel of an ISDN system is known to one of ordinary skill in the art to carry data and thus inherently carries data.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's argument concerning a GSM organization channel carrying a telephone number, the examiner respectfully disagrees, the GSM organizational channel is known to one of ordinary skill in the art to carry data, further transmission of a telephone number, which is data, is disclosed by Rondeau.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

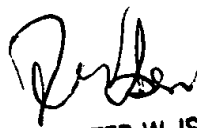
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JFH
September 29, 2002



FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2000